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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,193	11/04/2003	Osamu Kurosawa	8305-234US (NP61-0002-1)	6237
570 7590 06/15/2010 PANITCH SCHWARZE BELISARIO & NADEL LLP ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103				
EXAMINER				
LANG, AMY T				
ART UNIT		PAPER NUMBER		
3731				
NOTIFICATION DATE		DELIVERY MODE		
06/15/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptomail@panitchlaw.com

### Office Action Summary

**Application No.**

10/701,193

**Applicant(s)**

KUROSAWA ET AL.

**Examiner**

AMY T. LANG

**Art Unit**

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 2 recite wherein the phosphorus compound comprises "salts of phosphites and thiophosphites obtained by reacting phosphites and thiophosphites with ammonia or an amine compound." However, the instant disclosure does not support this limitation. Paragraph [0034] of the instant specification only teaches salts of a monophosphite or diphosphite reacted with an ammonia or amine compound. Therefore, the specification does not provide support for the broadly claimed phosphites and thiophosphites reacted with the ammonia or amine, but only monophosphites or diphosphite. Claim 3 is dependent on claim 1 and therefore is also not supported by the instant disclosure.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cain (US 2003/0000866 A1) in view of Chambard et al. (US 2002/0082176 A1), Komiya et al. (US 2001/0044389 A1), and Sung et al. (US 4,169,799).

Cain discloses a lubricating oil for transmissions comprising a mineral base oil having a kinematic viscosity from about 3.0 to about 7.5 cSt at 100°C ([0019]; [022]). The composition further comprises a phosphorus compound including dialkylthiophosphites and trialkylphosphites ([0147]). These compounds are present in the composition from about 0.1wt% to about 10wt% so that the amount of phosphorus based on the total mass of the composition clearly overlaps the instantly claimed range ([0099]). Cain also teaches a polymethacrylate viscosity index improver having a molecular weight from about 800 to about 6000 ([0029]). These viscosity index improvers are added to the composition from about 3wt% to about 40wt% which is a sufficient amount to raise the kinematic viscosity of the composition to about 5.0 to 6.0 mm<sup>2</sup>/s at 100°C, absent evidence to the contrary.

Although Cain discloses a sulfur-containing compound in an amount so that sulfur is less than 0.15 percent by mass based on the total composition, Cain teaches the sulfur-containing compound as dithiocarbamate ([0056]; [0197]). The instant specification teaches that both dithiocarbamates and thiadiazoles are suitable in a lubricating composition ([0056]). Therefore, the specification does not provide criticality for having a thiadiazole over a dithiocarbamate so that it is the Examiner's position that substituting the dithiocarbamate of Cain for a thiadiazole would have been obvious at the time of the invention. Furthermore, Cain discloses the dithiocarbamate as an antiwear agent. Chambard et al. teaches that both thiadiazoles and dithiocarbamates are well known antiwear agents that may be substituted for each other ([0061]). Therefore, it also would have been obvious at the time of the invention to one of ordinary skill in the art for Cain to use a thiadiazole for the antiwear agent in view of Chambard et al.

Although Cain teaches the lubricating oil as mineral oil, specifically paraffinic oil, Cain does not specifically disclose the %Cp of the oil ([0021])

Komiya et al. (hereinafter Komiya) discloses a lubricating composition comprised of mineral oil, including paraffinic oils ([0002], [0012], [0016]). The disclosed mineral oil has a kinematic viscosity of 1 to 4 mm<sup>2</sup>/s, which clearly overlaps the instant claims ([0014]). Additionally, the % Cp of the oil is disclosed as 70 or higher as defined by ASTM D 3238 ([0012]). It is the examiner's position that the transmission oils disclosed by Cain and Komiya both contain similar mineral oils, paraffinic oils at the same viscosity, and would therefore display the same characteristics. Komiya specifically

uses mineral oil with a % Cp from 75 to 81 since base oil in this range of % Cp displays excellent low temperature fluidity (Table 1, page 8, [0013]). Therefore, it would have been obvious to one of ordinary skill at the time of the invention for the transmission disclosed by Cain to comprise a base mineral oil having a % Cp from 75-81 for the advantages of enhanced low temperature fluidity as taught by Komiya.

Although Cain teaches the use of other additives, including detergents, Cain does not specifically disclose a calcium sulfonate detergent ([0217]).

Sung et al. (hereinafter Sung) teaches that calcium sulfonates are well known in the art as detergents for use in lubricating compositions (column 9, lines 48-49). Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art for Cain to also utilize a calcium sulfonate for the disclosed detergent.

### ***Response to Arguments***

6. Applicant's arguments filed 03/16/2010 have been fully considered but they are not persuasive. Applicant argues that Cain teaches the lubricating composition may comprise an amine antioxidant, a dithiocarbamate antioxidant, and a sulfur-containing antioxidant which all contain sulfur. Therefore, Cain actually contains more than the claimed 0.15 percent by mass of sulfur. However, Cain teaches the composition *may* comprise these additional additives so that Cain also teaches an embodiment where the additives are not present and Cain meets the claimed sulfur requirements.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMY T. LANG whose telephone number is (571)272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

06/08/2010

/Amy T Lang/

Examiner, Art Unit 3731

/Anh Tuan T. Nguyen/

Supervisory Patent Examiner, Art Unit 3731

6/8/10